

REMARKS

In the last Office Action, the Examiner rejected claims 5, 6 and 20 under 35 U.S.C. §112, first paragraph, as containing new matter. More specifically, the Examiner noted that the specification lacks support for the subject matter "at least one hand" in claims 5 and 6 and "for controlling movement of the hands" in claim 20. Claims 1-4 and 7-19 were allowed over the prior art of record.

In accordance with the present response, claims 5, 6 and 20 have been amended to delete the new matter noted by the Examiner. More specifically, claims 5 and 6 have been amended to recite "one of the hands" instead of "at least one hand", and claim 20 has been amended to recite "for controlling movement of one of the hands" instead of "for controlling movement of the hands."

By the foregoing amendment to claims 5, 6 and 20, applicants respectfully submit that the rejection of these claims under 35 U.S.C. §112, first paragraph, has been overcome and should be withdrawn.

Applicant further submits herewith a fourth supplemental reissue declaration to reflect the foregoing amendments to claims 5, 6 and 20.

Request for Interference with U.S. Patent No. 5,329,501

By this response, and further to the request in the letter to the Examiner filed with the present application on June 23, 1995 and the requests in the supplemental response filed February 27, 1997, the supplemental response filed November 3, 1997, and the second supplemental response filed November 24, 1997, applicant requests that an interference now be declared with U.S. Patent No. 5,329,501.

Pursuant to 37 C.F.R. §1.607, applicant provides the following information:

(1) **Identification of the Patent**

The interfering patent is U.S. Patent No. 5,329,501 which issued July 12, 1994 in the names Pierre-Andre Meister and Andreas Tschanz.

(2) **Presentation of a Proposed Count**

Applicant proposes the following count in place of the count proposed in the supplemental response filed November 3, 1997:

Proposed Count

An electronic watch with a pager for displaying paging messages comprising: a receiver for receiving paging messages; a time indicating device having a dial, and a plurality of movable hands disposed over the dial for

indicating time; marks disposed on the dial representative of different paging messages; a memory for storing the paging messages received by the receiver; a transducer for signalling the receipt of a paging message by the receiver; and a circuit means for receiving paging messages from the receiver and, in response to receiving one of the paging messages, for controlling movement of one of the hands of the time indicating device to stop indicating time and to indicate the mark representing the paging message.

(3) **Identification of Claim in the Patent Corresponding to the Proposed Count**

Applicant identifies independent Claim 1 in U.S. Patent No. 5,329,501 as corresponding to the proposed count.

(4)

(a) **Identification of Claim in the Present Application Corresponding to the Proposed Count**

Applicant identifies independent claim 20 in the present application as corresponding exactly to the proposed count.

(b) **Explanation of Why Claim 1 of U.S. Patent No. 5,329,501 Corresponds to the Proposed Count**

Claim 1 of U.S. Patent No. 5,329,501 corresponds to the proposed count and both are drawn to the same patentable invention. The only differences between Claim 1 of Patent No.

5,329,501 and the proposed count are shown by the following underlined language which is present in Claim 1 but either omitted from, or more broadly worded in, the proposed count:

- (a) a dial surrounded by a bezel;
- (b) a receiver capable of receiving radio broadcast messages for seeking persons;
- (c) reception being triggered by the composition on a telephone handset of one of at least two predetermined and distinctive calling numbers;
- (d) a control arrangement including at least one stem fitted into a crown adapted to be manually actuated; and
- (e) the calling numbers are inscribed on the dial or the bezel in plain language or in coded form.

With respect to the recitations in sub-paragraphs (a) and (d), it is notoriously commonplace in the analog timepiece art to provide a bezel surrounding the dial and to use a control arrangement having a crown and stem to manually adjust the position of the timepiece hands, and inclusion in Claim 1 of a bezel and a control arrangement including a crown and a stem is not a patentable distinction over the proposed count. Stated otherwise, inclusion of a bezel, stem and crown in the proposed count would not amount to a patentable difference.

With respect to the recitation in sub-paragraph (b), it is commonplace in the pager art to provide pager systems with a receiver for receiving radio broadcast paging messages and, therefore, this feature is not a patentable distinction over the proposed count.

With respect to the recitation in sub-paragraph (c), it is commonplace in the pager art to trigger radio broadcast messages (i.e., paging messages) by inputting call numbers via a telephone line. In a conventional pager, for example, when a call number of a person being called or paged is inputted to a telephone, the call signal thereof is given to a radio paging station through a telephone network and then transmitted therefrom to a high frequency receiving element. Accordingly, the recitation reception being triggered by the composition on a telephone handset of one of at least two predetermined and distinctive calling numbers recited in Claim 1 is not a patentable distinction over the proposed count.

With respect to the recitation in sub-paragraph (e), the use of calling numbers inscribed on the dial in plain language or in coded form constitutes an obvious and trivial variation and, therefore, is not patentably distinct from the "marks disposed on the dial representative of different paging messages" recited in the proposed count. Furthermore, the

recitation in Claim 1 of inscribing the calling numbers on either the dial or the bezel cannot be patentably distinct from inscribing them on the dial since Claim 1 recites that the inscriptions may be on either the dial or bezel.

(5) **Application of the Terms of Claim 20 of the Application to the Disclosure of the Application**

CLAIM 20 IN APPLICATION	SUPPORT IN APPLICATION
An electronic watch with a pager for displaying paging messages comprising:	Figs. 1-9, specification and claims disclose an electronic watch with a pager; Figs. 6-9 show the electronic watch displaying paging messages
a receiver for receiving paging messages;	High frequency receiving circuit 1 in Fig. 1
a time indicating device having a dial, and a plurality of movable hands disposed over the dial for indicating time;	Figs. 6-9 show a time indicating device which indicates time by means of movable hands disposed over the dial
a mark representing a paging message disposed on the dial;	Figure 8 shows identifying marks "CUSTOMER", "HOME", etc. disposed on the dial 38
a memory for storing the paging messages received by the receiver;	Received information storing circuit 9 in Figure 1
a transducer for signaling the receipt of a paging message by the receiver;	Alarm element 5; See column 5, line 24 et seq.

circuit means for receiving paging messages from the receiver and, in response to receiving one of the paging messages, for controlling movement of one of the hands of the time indicating device to stop indicating time and to indicate the mark representing the paging message.

See, for example, column 5, lines 9-44 describing the received information storing circuit; column 4, lines 29-40 describing the analog display unit; and column 5, line 57 et seq. which states "the user can identify the caller by seeing a digital mark on a digit dial 36 pointed by a second hand 37 (pager information indicating hand in this embodiment)

**(6) Explanation of How the Requirements
of 35 U.S.C. §135(b) Are Met**

Claim 20 is for the same or substantially the same subject matter as claim 6, which was present in this reissue application prior to one year from the date on which U.S. Patent No. 5,329,501 was granted, and claim 6 is for the same or substantially the same subject matter as claim 1 of the '501 patent. In view thereof, the requirements of 35 U.S.C. §135(b) have been met.

In view of the foregoing, the application is now believed to be in condition for allowance. Accordingly, applicant respectfully requests that an interference be declared with U.S. Patent No. 5,329,501 and that claims 1-20 of the '501 patent be designated as corresponding to the count.

In view of the foregoing, claims 1-20 are now believed to be in allowable form. Accordingly, favorable reconsideration and allowance of the claims are most respectfully requested. Applicant also requests that an interference be declared with U.S. Patent No. 5,297,118 as heretofore requested.

Respectfully submitted,

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MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner of Patents & Trademarks, Washington, D.C. 20231, on the date indicated below.

Bruce L. Adams

Attorney Name

Signature

APRIL 27, 1998

Date